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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,315	04/10/2002	Alejandro Berenstein	S63.2-10039	6886
490	7590	05/03/2006	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			WEBB, SARAH K	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/063,315

Applicant(s)

BERENSTEIN ET AL.

Examiner

Sarah K. Webb

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-41 and 43-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-41 and 43-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 38-41 and 43-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle in view of US Patent No. 5,911,732 to Hojeibane.

Hojeibane discloses a stent in Figure 3 that includes a coil segment (5) that connects two non-coil segments (271,272). Figures 1 and 4 show an example of the non-coiled segments, which are considered to be "serpentine." Hojeibane explains that the stent can be either balloon expandable (column 8, lines 23-25) or self-expandable (column 9, lines 15-17). The coil segment, or connector, is made of thin steel (column 7, line 11). Since the connector (5) is steel and in the shape of a coil, or spring, it is inherently "spring steel." Hojeibane is considered to meet the new limitations, since the coil can be described as having "curved portions." A "curved portion" can simply be a segment of one of the turns of the helix. The helix extends 360 degrees around the longitudinal axis, so there are clearly portions of a turn that extend at least 90 degrees around the longitudinal axis. Adjacent "portions" are annularly aligned, longitudinally offset, and maintain a constant longitudinal distance from one another.

Hojeibane fails to form the coil segment to have a greater length than the non-coil segments. Hojeibane does state that the connector (5) can be varied to increase or decrease the flexibility of the stent (column 7, lines 34-41). It would have been

Art Unit: 3731

obvious to one of ordinary skill in the art at the time the invention was made to form the coil segment to have a greater length than the non-coil segments, as Hojeibane teaches that this component may be altered to increase or decrease flexibility. This modification would have involved a mere change in the size of a component, which is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 40: Hojeibane discloses the segmented stent in Figure 3 to have multiple coil segments instead of only one coil segment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to limit the stent length to include only one coil segment connecting two serpentine segments, as this simple modification would allow the stent to be implanted within a shorter passageway in the body.

Regarding claims 51-53, Hojeibane fails to limit the diameter of the stent to 6 mm and the length to 20 mm. Hojeibane does state that the expanded diameter of the stent is variable (column 5, line 62) and the length can range from 3 cm (30 mm) to 18 cm (column 6, line 57). Applicant admits in the specification (paragraph 69) that the diameter of the stent can range from 1.5 mm to 25 mm and the length of the stent can range from 3 mm to 100 mm. It would have been an obvious matter of design choice to alter the dimensions of the Hojeibane stent, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Response to Arguments

1. Applicant's arguments, see page 4, filed 4/20/06, with respect to the objection, have been fully considered and are persuasive. The objection to claims 38 and 46 has been withdrawn.

Art Unit: 3731

2. Applicant's arguments, see page 4, filed 4/20/06, with respect to the 102 rejection(s) of claim(s) 38-40, 44-47, 49, and 51-53 under Boyle et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Hojeibane.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K. Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW

4/30/06

SKW
Julian W. Woo

JULIAN W. WOO
PRIMARY EXAMINER